

REMARKS

Status of the Claims

Applicants have canceled Claims 1-26 and 31 without prejudice or disclaimer. Applicants provisionally withdraw Claims 42-46 without prejudice or disclaimer. Applicants have amended Claims 32, 39 and 41. Applicants have added new Claim 47, and Applicants submit that Claim 47 is allowable over the cited references.

Claims 42-46 are Provisionally Withdrawn

The Office Action has withdrawn Claims 42-46, at paragraph 1 of the Office Action, as being directed to a non-elected invention. Applicants provisionally withdraw Claims 42-46 without prejudice or disclaimer. The restriction is respectfully traversed in order to preserve the issue for subsequent petition since the examination of all of the claims is not believed to create an undue burden on the USPTO and that the subject matter among the groups is not independent and distinct as required by statute. Furthermore, different classifications as recited by the USPTO are not independent adequate grounds for restriction, since the USPTO has historically examined applications containing multiple sets of claims with different classifications. Applicants request reconsideration and withdrawal of the restriction requirement.

Claim 39 is Allowable

The Office has rejected Claims 31 and 39, at paragraphs 2 and 3 of the Office Action, under 35 U.S.C. §112 second paragraph, for failing to comply with the written description requirement. Applicants have canceled Claim 31 without prejudice or disclaimer. Applicants have amended Claim 39. Applicants submit that Claim 39 is allowable, and request withdrawal of the 35 U.S.C. §112 second paragraph rejection.

Claim 41 is Allowable

The Office has objected to Claim 41, at paragraph 22 of the Office Action, as being dependent on a rejected base claim. In accordance with the Office Action, Applicants have rewritten Claim 41 in independent form, including all of the elements of Claim 35. Applicants submit that Claim 41 is in condition for allowance, and request allowance of Claim 41.

Claims 27-28, 35 and 37-38 are Allowable

The Office has rejected Claims 27-28, 35 and 37-38, at paragraphs 4-10 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,986,200 ("Curtin") in view of U.S. Patent No. 6,152,856 ("Studor") and U.S. Patent No. 6,928,433 ("Goodman"). Applicants respectfully traverse the rejections.

None of the cited references, including Curtin, Studor and Goodman, disclose or suggest the specific combination of Claim 27. For example, Curtin does not disclose or suggest a processor to receive biometric data and to select one of a plurality of audio tracks according to the biometric data, as recited in Claim 27. In contrast to Claim 27, Curtin discloses that musical playback parameters such as tempo and key may be varied in accordance with a monitored characteristic such as heart rate. *See* Curtin, col. 4, lines 4-9. Studor discloses that music can be chosen to complement a portion of a workout in which a user is engaged, but fails to disclose or suggest a processor to select one of a plurality of audio tracks according to biometric data, as recited in Claim 27. *See* Studor, col. 13, lines 59-63. Goodman discloses that a playlist may be established by accepting signals from a user input control to select a category, selecting songs within the category, and adding the selected songs into a playlist cue, but Goodman fails to disclose or suggest a processor to select one of a plurality of audio tracks according to biometric data, as recited in Claim 27. *See* Goodman, col. 2, lines 58-63. Therefore, Curtin, Studor, and Goodman, taken separately or in combination, fail to disclose or suggest each and every element of Claim 27. Hence, Claim 27 is allowable.

Claim 28 depends from Claim 27, which Applicants have shown to be allowable. Hence, Curtin, Studor, and Goodman fail to disclose at least one element of Claim 28. Accordingly, Claim 28 is also allowable, at least by virtue of its dependence from Claim 27.

None of the cited references, including Curtin, Studor and Goodman, disclose or suggest the specific combination of Claim 35. For example, Curtin does not disclose or suggest selecting an audio track of a plurality of audio tracks from a memory of a portable audio device based on the biometric data, as recited in Claim 35. In contrast to Claim 35, Curtin discloses that musical playback parameters such as tempo and key may be varied in accordance with a monitored

characteristic such as heart rate. *See* Curtin, col. 4, lines 4-9. Studor discloses that music can be chosen to complement the portion of a workout in which a user is engaged, but fails to disclose or suggest selecting one of a plurality of audio tracks according to biometric data, as recited in Claim 35. *See* Studor, col. 13, lines 59-63. Goodman discloses that a playlist may be established by accepting signals from a user input control to select a category, selecting songs within the category, and adding the selected songs into a playlist cue, but Goodman fails to disclose or suggest selecting one of a plurality of audio tracks according to biometric data, as recited in Claim 35. *See* Goodman, col. 2, lines 58-63. Therefore, Curtin, Studor, and Goodman, taken separately or in combination, fail to disclose or suggest each and every element of Claim 35. Hence, Claim 35 is allowable.

Claims 37 and 38 depend from Claim 35, which Applicants have shown to be allowable. Hence, Curtin, Studor, and Goodman fail to disclose at least one element of each of Claims 37 and 38. Accordingly, Claims 37 and 38 are also allowable, at least by virtue of their dependence from Claim 35.

Further, there is no motivation in any of the cited references to make the asserted combination. One skilled in the art would not be motivated to combine the portable playback device whose musical playback parameters (e.g., tempo and key) may vary in accordance with a monitored characteristic (e.g., heart rate) or user specification of Curtin, with the exercise equipment playing pre-selected audio tracks of Studor, and with the user track selection interface of Goodman. Each of the references is directed toward solving a distinct and unrelated problem: Curtin addresses user control of playback parameters, such as tempo and key, for applications that may include karaoke and exercising. Studor addresses facilitating user selection of pre-recorded video and audio in a system to simulate exercising in a natural setting. Goodman addresses automatic categorization of musical tracks for a user interface that promotes ease in selecting a playback order of a portable music playback device. There is no motivation for the asserted combination of Curtin, Studor and Goodman except that provided by Applicants' disclosure. Therefore, the combination represents an impermissible hindsight reconstruction, and should be withdrawn.

Claims 29-30, 32-34 and 39-40 are Allowable

The Office has rejected Claims 29-34 and 39-40, at paragraphs 11-19 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over Curtin in view of Studor, Goodman, and further in view of U.S. Patent No. 6,132,337 ("Krupka"). Applicants have canceled Claim 31 without prejudice or disclaimer. Applicants respectfully traverse the remaining rejections.

Krupka does not disclose or suggest the elements of Claims 27 and 35 that were not disclosed by Curtin, Studor, and Goodman. For example, Krupka fails to disclose or suggest a processor to receive biometric data and to select one of a plurality of audio tracks according to biometric data, as recited in Claim 27. Krupka also fails to disclose or suggest selecting an audio track of a plurality of audio tracks from a memory of a portable audio device based on the biometric data, as recited in Claim 35. In contrast to Claims 27 and 35, Krupka discloses an exercise monitor system receiving user parameters such as heart rate and motion and displaying exercise parameter indicators, a desired motion parameter for comparison, and an animated image. *See* Krupka, Abstract, and col. 3, lines 43-58. Claims 29-30, 32-34 depend from Claim 27. Therefore, Claims 29-30 and 32-34 are allowable, at least by virtue of their dependence from Claim 27. Claims 39 and 40 depend from Claim 35. Therefore, Claims 39 and 40 are allowable, at least by virtue of their dependence from Claim 35.

Further, Krupka does not disclose or suggest a processor adapted to select a first audio track of a plurality of audio tracks when biometric data exceeds a threshold, as recited in Claim 32. In contrast to Claim 32, Krupka discloses that if a user's real time heart rate is greater than or equal to a value R3, a tempo of an audio output is decreased. *See* Krupka, col. 5, lines 8-11. For at least this additional reason, Claim 32 is allowable.

Further, Studor does not disclose or suggest a processor adapted to store biometric data in memory, as recited in Claim 33. In contrast, Studor discloses a Graphical User Interface that executes real-time display and recording of exercise data, but Studor fails to disclose storing biometric data in memory, as recited in Claim 33. *See* Studor, col. 6, lines 37-42. For at least this additional reason, Claim 33 is allowable.

Further, Krupka does not disclose or suggest selecting a first audio track of a plurality of audio tracks when pulse rate data exceeds a threshold, as recited in Claim 39. In contrast to Claim 39, Krupka discloses that if a user's real time heart rate is greater than or equal to a value R3, a tempo of an audio output is decreased. See Krupka, col. 5, lines 8-11. For at least this additional reason, Claim 39 is allowable.

Further, Krupka does not disclose or suggest converting the biometric data to a particular format, as recited in Claim 40. In contrast to Claim 40, Krupka discloses a microprocessor 54 that outputs serial data via an RF transmitter 58 and an antenna 46 to a wireless receiver assembly 12, which outputs via a serial interface 60 to a computer 10, but Krupka does not disclose converting data to a particular format. See Krupka, col. 4, lines 22-25. For at least this additional reason, Claim 40 is allowable.

Further, there is no motivation in any of the cited references to make the asserted combination. One skilled in the art would not be motivated to combine the portable playback device whose musical playback parameters may vary in accordance with a monitored characteristic of Curtin, with the exercise equipment that plays pre-selected audio tracks of Studor, and with the user track selection interface of Goodman, and with the exercise motion user parameter display system of Krupka. Each of the cited references addresses a distinct and unrelated problem: Curtin addresses user control of playback parameters such as tempo, duration of selection, and key, for applications such as karaoke and exercising. Studor addresses facilitating user selection of pre-recorded video and audio in a system to simulate exercising in a natural setting. Goodman addresses automatic categorization of musical tracks for a user interface that promotes ease in selecting a playback order of a portable music playback device. Krupka addresses providing computer generated visual and audio cues to a user in order to influence the user's exercise session, e.g., reducing audio output tempo in order to effect a slowed heart rate. There is no motivation for the asserted combination of Curtin, Studor, Goodman and Krupka, except that provided by Applicants' disclosure. Therefore, the combination represents an impermissible hindsight reconstruction, and should be withdrawn.

Claim 36 is Allowable

The Office has rejected Claim 36, at paragraphs 20-21 of the Office Action, under 35 U.S.C. §103(a), as being unpatentable over Curtin in view of Studor, Goodman, and further in view of U.S. Patent No. 6,662,032 ("Gavish"). Applicants respectfully traverse the rejection.

Gavish does not disclose the elements of Claim 35 that were not disclosed by Curtin, Studor and Goodman. For example, Gavish does not disclose or suggest selecting an audio track of a plurality of audio tracks from a memory of a portable audio device based on the biometric data, as recited in Claim 35. In contrast to Claim 35, Gavish discloses a diagnostic device including a first sensor to measure a first physiological variable indicative of a voluntary action of a user, a second sensor governed by an autonomic nervous system of the user, and circuitry to generate an output signal directing the user to modify a parameter of the voluntary action. See Gavish, Abstract. Claim 36 depends from Claim 35. Therefore, Claim 36 is allowable, at least by virtue of its dependence from Claim 35.

Further, there is no motivation in any of the cited references to make the asserted combination. One skilled in the art would not be motivated to combine the portable playback device whose musical playback parameters may vary in accordance with a monitored characteristic of Curtin, with the exercise equipment that plays pre-selected audio tracks of Studor, and with the user track selection interface of Goodman, and with the system for measuring voluntary and autonomic physiological variables of Gavish. There is no motivation for the asserted combination of Curtin, Studor, Goodman and Gavish, except that provided by Applicants' disclosure. Therefore, the combination represents an impermissible hindsight reconstruction, and should be withdrawn.

CONCLUSION

Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the objections and rejections, as well as an indication of the allowability of each of the pending claims.

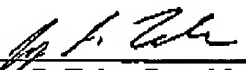
Any changes to the claims in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

4-23-2007
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicants
TOLER SCHAFFER, L.L.P.
8500 Bluffstone Cove, Suite A201
Austin, Texas 78759
(512) 327-5515 (phone)
(512) 327-5575 (fax)